

Remarks

Claims 22-29 and 43-60 are pending in the subject application. Applicants acknowledge that claims 24-26, 43-47, 50-52 and 56-60 have been withdrawn from further consideration. By this Amendment, Applicants have amended claim 22, and added claims 61-66. Support for the amendments and new claims can be found throughout the subject specification (see, for example, page 3, paragraph 11) and in the claims as originally filed. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 22, 23, 27-29, 48, 49, 53-55, and 61-65 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Claims 22, 23, 27, 29, 48, 49, 53 and 55 are rejected under 35 U.S.C. § 102(b) as anticipated by Gould *et al.* (U.S. Patent No. 4,676,985). Applicants respectfully traverse and request reconsideration.

It is well settled that in order for the Patent Office to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Additionally, the Patent Office cannot establish inherency merely by demonstrating that the asserted limitation is probable or possible. *In re Oerlich*, 666 F.2d 578, 581 (C.C.P.A. 1981). "Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency." *Scaltech, Inc. v. Retectetra, L.L.C.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999). *See also Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991) ("When the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.").

Applicants respectfully assert that the Gould *et al.* patent does not anticipate the claimed invention for the following reasons. First, with regard to claims 22, 23, 27, 29, 48, 49, 53, and 55, the patent does not teach any method for controlling weeds or plant pathogens such as a fungal

pathogen. With regard to claims 61-64, the patent does not teach, either expressly or under the principles of inherency, the application of a *Monarda* spp. (*i.e.*, bergamot) composition to: 1) soil, greenhouse growing media, or nursery growing media as an amendment; or 2) as top dressing for potted plants. Rather, the Gould *et al.* patent is explicit that the liquid bergamot extract is coated directly on seeds, and used as a feeding deterrent, effective against only one type of soil-inhabiting insects – the corn wireworms and not effective against any other insects such as rootworms (Gould *et al.* at column 1, line 54 to column 2, line 16 and column 3, lines 35-39).

Applicants respectfully note that none of the failures in the teachings of Gould *et al.* noted above is remedied by the assertion at page 2 of the Office Action, that “Gould *et al.* make it inherent that the extract would eventually contact the soil because Gould *et al.* teach that the seed or below-ground portion of the seedling coated with a bergamot extract is planted in the field.” Even if the extract eventually contacts the soil, as is alleged in the Office Action, the bergamot extract is still coated on the seeds, not applied to the soil or in any media as an amendment or as top dressing for potted plants as is required by the claims. Furthermore, it is of no utility and thus counterintuitive to apply the bergamot extract, which is taught as a feeding deterrent against soil-inhabiting corn wireworms, to the sites claimed in the present invention when the worms do not feed on soil, growing media or top dressing.

Applicants further submit that Gould *et al.* fail to anticipate the claimed invention as it does not teach the application of fresh or dried plant material (foliage; see page 4, paragraph 12) to soil, greenhouse growing media, nursery growing media as an amendment to the soil or media nor do Gould *et al.* teach the use of fresh or dried plant material as top dressing for potted plants and it is unclear how the liquid extract taught in Gould *et al.* can reasonably be construed as such. Thus, teachings in Gould *et al.*, at minimum, fail to “make clear that the missing descriptive matter is necessarily present in the thing described in the reference” as required under *Cont'l Can Co. USA, Inc. v. Monsanto Co.* Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) is respectfully requested.

Claims 22, 23, 27-29, 48, 49 and 53-55 are rejected under 35 U.S.C. § 103(a) as obvious over Gould *et al.* (U.S. Patent No. 4,676,985). Applicants respectfully traverse because Gould *et al.* do not teach or suggest the present invention.

As the Patent Office is aware, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, each of three basic criteria must be met in order to establish a *prima facie* case of obviousness. First, there must be an apparent reason for some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. at 1941. In addition, there must be a reasonable expectation of success. (The *KSR* Court held that “a simple arrangement of old elements with each performing the same function it had been known to perform” must further yield no more than one would expect from such an arrangement.) *Id.* at 1941. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

As discussed above, with regard to claims 22, 23, 27-29, 48, 49 and 53-55, Gould *et al.* fail to teach or suggest any method for controlling weeds or plant pathogens such as a fungal pathogen. With regard to claims 61-64, the reference also fails to teach or suggest a method for controlling plant pests by applying a solid (fresh or dried) *Monarda* spp. (*i.e.*, bergamot) composition to the soil or in any media as an amendment or as top dressing for potted plants. As noted above, it is of no utility and thus counterintuitive to apply the bergamot extract, a feeding deterrent against soil-inhabiting corn wireworms, to the sites claimed in the present invention where the worms do not feed on, such as in the soil, growing media or top dressing and none of the above noted deficiencies is remedied by the assertion that “Gould *et al.* make it obvious that the extract would eventually contact the soil.”

When the references fail to teach every limitation of the claims, an invention is not obvious. *See CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (holding that a determination of non-obviousness was correct when “no combination of the cited prior art, even if supported by a motivation to combine, would disclose all the limitations of the claims”). Furthermore, as the Supreme Court stated, “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex*

Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Applicants submit that the cited reference fails to teach each and every limitation of the claimed invention. For example, there is no teaching in Gould *et al.* of the application of solid plant material to soil as either an amendment or as top dressing. The Office Action, recognizing this failure in the teachings of Gould *et al.*, argues that “the instant specification does not provide unexpected data for the dry form versus the liquid or extract form. In the absence of unexpected data for the dried form, Gould *et al.*’s extract of liquid form makes obvious the dried form claimed. Note, both physical forms contain the same active ingredient and therefore [sic] both forms should yield the same or similar result when employed in the same method.” Yet, while this argumentation may satisfy the requirement for “articulated reasoning” as required by the Supreme Court, this argumentation does not provide the requisite rational underpinning necessary to support the legal conclusion of obviousness. Rather, the argumentation provided in the Office Action is merely conclusory statements offered to support the rejection of record as there is no evidence of record that establishes that the liquid extract of Gould *et al.* would be expected to contain the same active ingredient as the solid materials applied to soil for the instant application. Therefore, it is respectfully submitted that a *prima facie* case of obviousness has not been established for any of the claims. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

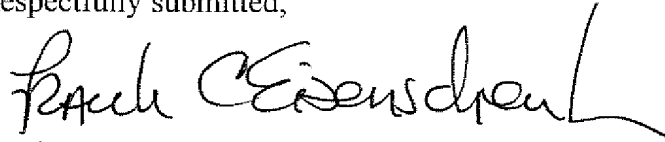
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants’ agreement with or acquiescence in the Examiner’s position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank C. Eisenschenk". The signature is fluid and cursive, with a long horizontal stroke at the end.

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